

REMARKS

I. Summary of the Office Action

Claims 1, 2, 6, 8, 11-18, 35, 36, 41, 44-48, and 61-64 are pending in this application.

Claims 1, 6, 12, 13, 16, 18, 35, 45, and 48 were rejected under 35 U.S.C. § 103(a) as being obvious from Young et al. U.S. Patent No. 5,353,121 ("Young") in view of Goldschmidt Iki et al. U.S. Patent No. 6,483,987 ("Iki").

Claims 2, 7-11, 14, 15, 17, 36, 40-44, 46, and 47 were rejected under 35 U.S.C. § 103(a) as being obvious from Young in view of Iki and further in view of Zigmond et al. U.S. Patent No. 6,698,020 ("Zigmond").

Claims 60 and 61 were rejected under 35 U.S.C. § 103(a) as being obvious from Young in view of Iki and further in view of Michaud WIPO Publication No. WO 99/57904 ("Michaud").

Claim 60 was objected to for a typographical error.

II. Summary of Telephonic Interview

Applicant and applicants' representatives, Matthew S. Bertenthal (Reg. No. 61,129) and Michael J. Chasan (Reg. No. 54,026), wish to thank the Examiner for the courtesy of the

June 25, 2008 telephonic interview. During the interview, the Examiner and applicant's representative discussed the differences between the claimed invention and the cited references.

III. Summary of the Applicants' Reply

Applicants have amended claim 60 to correct for a typographical error. Accordingly, the Examiner's objection to claim 60 should be withdrawn.

Applicants have cancelled claims 7, 9, 10, 40, 42, and 43 without prejudice and have amended claims 1, 35, and 61 to more particularly define the claimed invention. Applicants have also added new claims 63 and 64. Support for amended claims 1 and 35 can be found at, for example, page 1, line 26 through page 2, line 5 of applicants' provisional Application No. 60/179,548 ("applicants' provisional application"). Support for new claims 63 and 64 can be found at, for example, page 1, lines 26-28 and page 2, lines 7-8 of applicants' provisional application.

The Examiner's rejections are respectfully traversed.

IV. Applicants' Reply to the § 103 Rejection

Claims 1, 6, 12, 13, 16, 18, 35, 45, and 48 were rejected under 35 U.S.C. § 103(a) as being obvious from Young in view of Iki. This rejection is respectfully traversed.

Applicants' independent claims 1 and 35 refer to, *inter alia*, a method and system for providing an integrated recorded program/promotion playback asset. The program/promotion playback asset is a customized playback experience of recorded programming in that one or more promotions are insertably recorded with respect to the recorded programming such that during playback, the recorded promotion(s) appear as if they were originally part of the recorded programming. The advertisement is inserted at one of the beginning of the program or the end of the program.

Young relates to a television schedule system that allows a user to control operation of a VCR through on screen television program listings (Young, 1:19-24).

Iki relates to a graphical user interface that allows a user to record a broadcast data selection without commercials by determining whether a commercial or program is being broadcast, and stopping the recording if a commercial is being broadcast (FIG. 7, 8:59-9:7 and 9:15-31).

On page 5 of the Office Action, the Examiner contends that Young discloses all of the elements of applicants' claims 1 and 35, but admits that Young does not explicitly disclose applicants' claimed steps of 1) selecting a promotion record for inclusion in the integrated recorded program/promotion playback asset; 2) recording the selected promotion for inclusion in the integrated recorded program/promotion playback asset; and 3) playing back the recorded program/promotion playback asset in response to receiving a user indication to play back the recorded program. To remedy these deficiencies, the Examiner relies on Iki.

Applicants respectfully submit that whether taken alone or in combination, Young and Iki fail to show or suggest every element of applicants' claims. Specifically, Young and Iki do not show recording a selected promotion for inclusion in a integrated recorded program/promotion playback asset such that the advertisement is inserted at one of the beginning of the program or the end of the program. As mentioned above, Iki determines whether a broadcast is a commercial, and then stops recording if a commercial is being broadcast. Recording a program so that is stripped of any commercials is in stark contrast to inserting a selected promotion at one of the

beginning or the end of a recorded program. Accordingly, Iki's recording scheme fails to disclose applicants' claimed feature. Further, Young fails to show or suggest such a recording scheme. Thus, Young and Iki, whether taken alone or in combination, fail to show or suggest every element of applicants' claims.

In addition, Iki teaches away from inserting a selected promotion at one of the beginning or the end of a recorded program. Iki's recording scheme either eliminates commercials from a recorded program, or allows for the recording of program with commercials. This recording scheme is the complete opposite of applicants' insertion of commercials into a recorded program. Thus, one skilled in the art faced with the problem of inserting selected promotions into recorded programs would not look to combine Young and Iki in order to realize applicants' claimed invention. Rather, one skilled in the art would use the recording scheme of Iki to allow a user to record programs without commercials. Accordingly, because Iki does not insert selected programs into recorded programs, but instead eliminates commercials, the combination of Young with Iki teaches away from applicants' independent claims 1 and 35.

For at least the foregoing reasons, amended independent claims 1 and 35 and dependent claims 2, 6, 8, 11-18, 36, 41, 44-48, which depend from either amended independent claim 1 or 35, are not obvious from Young in view of Iki. This rejection should therefore be withdrawn.

V. Conclusion

In view of the foregoing, claims 1, 2, 6, 8, 11-18, 35, 36, 41, 44-48, and 60-64 are allowable. This application is therefore in condition for allowance. Reconsideration and allowance of this application are respectfully requested.

Respectfully submitted,
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